



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Matters Related to First Inventor to File

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act, invites comments on a proposed extension of an existing information collection: 0651-0069 (Matters Relating to First Inventor to File).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651-0071 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to

Raul.Tamayo@uspto.gov with “0651-0071 comment” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The United States Patent System uses a ‘first to file’ system, as introduced by the Leahy-Smith America Invents Act (AIA) in 2011. To determine the first inventor to file, information is needed in order to identify the inventorship and ownership, or obligation to assign ownership, of each claimed invention on its effective filing date.

This collection covers information gathered on various forms or submissions used by the USPTO to determine the first inventor to file. One form, required by 37 CFR 1.55(k), 1.78(a)(6) and 1.78(d)(6) provides information needed to assist the USPTO in determining whether an application is subject to 35 U.S.C. 102 and 103 as amended by Section 3 of the AIA, or 35 U.S.C. 102 and 103 as was in effect on March 15, 2013.

Additional information provided to USPTO (37 CFR 1.110) identifies the inventorship and ownership, or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, in an application or patent naming one or more joint inventors, when necessary for purposes of a USPTO proceeding.

Applications may also need to submit additional affidavits or declarations (37 CFR 1.130, 1.131, and 1.132) for several possible situations:

- (i) to show that a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor (1.130),
- (ii) (ii) to show that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor (1.130),
- (iii) (iii) to establish prior invention or to disqualify a commonly owned patent or published application as prior art (1.131), or
- (iv) (iv) to submit evidence to traverse a rejection or objection on a basis not otherwise provided for (1.132).

II. Method of Collection

The USPTO anticipates both electronic and paper submissions in this collection; electronically when using the USPTO online filing system EFS-Web, or by mail, facsimile, or hand delivery.

III. Data

OMB Number: 0651–0071.

IC Instruments and Forms: The individual instruments in this collection, as well as any associated forms, are listed in the hourly cost burden table below.

Type of Review: Extension of a currently approved collection.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: The USPTO estimates that it will receive a total of approximately 23,681 responses per year for this collection. The USPTO estimates that approximately 20,975 of the responses for this collection will be submitted electronically via EFS-Web.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected by these items.

Estimated Time per Response: The USPTO estimates that the responses in this collection will take the public from 2 to 10 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO. The USPTO calculates that, on balance, it takes the same amount of time to gather the necessary information, create the document, and submit it to the USPTO, whether the applicant submits the information in paper form or electronically.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected and the length of time necessary to complete responses containing similar or like information.

Estimated Total Annual Respondent Burden Hours: 207,362 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$90,824,556.00. The USPTO expects that attorneys will complete the instruments associated with this information collection. The professional hourly rate for attorneys is \$438, based upon the 2017 Report of the Economic Survey published by AIPLA. Using this hourly rate, the

USPTO estimates \$90,824,556.00 per year for the total hourly costs associated with respondents.

IC Number	Information Collection Instrument	Estimated time for response (hours) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total (c)x(d) = (e)
1	Electronic Submissions Under 37 CFR 1.55(k)	2	1,700	3,400	\$438.00	\$1,489,200.00
1	Submissions Under 37 CFR 1.55(k)	2	50	100	\$438.00	\$43,800.00
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	2	1,375	2,750	\$438.00	\$1,204,500.00
2	Submissions Under 37 CFR 1.78(a)(6)	2	25	50	\$438.00	\$21,900.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	2	340	680	\$438.00	\$297,840.00
3	Submissions Under 37 CFR 1.78(d)(6)	2	10	20	\$438.00	\$8,760.00
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	147	294	\$438.00	\$128,772.00
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	3	68	\$438.00	\$29,784.00
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	19,600	196,000	\$438.00	\$85,848,000.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	400	4,000	\$438.00	\$1,752,000.00
Total	---	---	23,681	207,362	---	\$90,824,556.00

Estimated Total Annual (Non-hour) Cost Burden: \$80.40. The USPTO estimates that the total annualized (non-hour) cost burden for this collection is due to postage costs. Customers may incur postage costs when submitting some of the items covered by this collection to the USPTO by mail. The USPTO expects that approximately 98 percent of the responses in this collection will be submitted electronically. Of the remaining 2

percent, the vast majority--98 percent--will be submitted by mail, for a total of 12 mailed submissions. The average first-class USPS postage cost for these items is estimated at \$6.70; the cost of a one pound mailed submission in a flat rate envelope. Therefore, the USPTO estimates that the postage costs for the mailed submissions in this collection will total \$80.40.

IV. Request for Comments

Comments are invited on:

- (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Marcie Lovett,

Director, Records and Information Governance Division,

Office of the Chief Technology Officer,

USPTO.

BILLING CODE 3510-16-P

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